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Total Number of Pages in This Submission

29

Application Number

10/719,8343

Filing Date

24 November 2003

First Named Inventor

Eastman, Michael Anthony

Art Unit

3727

Examiner Name

Shian T. Luong

Attorney Docket Number

US2005-834

ENCLOSURES (Check all that apply)

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Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

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Express Abandonment Request

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Information Disclosure Statement

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Certified Copy of Priority Document(s)

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Reply to Missing Parts/
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under 37 CFR 1.52 or 1.53

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Drawing(s)

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Licensing-related Papers

☐

Petition

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Petition to Convert to a
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☐

Power of Attorney, Revocation

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After Allowance Communication to TC

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Appeal Communication to Board
of Appeals and Interferences

☒

Appeal Communication to TC.
(Appeal Notice, Brief, Reply Brief)

☐

Proprietary Information

☒

Status Letter

☐

Other Enclosure(s) (please identify
below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

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Signature

Printed name

Matthew T. Welker, Esq.

Date

19 November 2007

Reg. No.

53,756

CERTIFICATE OF TRANSMISSION/MAILING

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Matthew T. Welker, Esq.

Date

19 November 2007

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DOCKET NO. 2005-834

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Michael Anthony Eastman
Serial No.: 10/719,834
Filed: 10/24/2003
For: Compact Mirrored Contact Lens Case

Art Unit: 3728
Examiner: Shian T. Luong

Cover Letter

Commissioner of Patents
Arlington, VA 22313-1450

Sir/Madam:


This is in response to the Notice of Non-Compliant Appeal Brief under 37 CFR 41.37 with a mailing date of October 23, 2007, having a response due by November 23, 2007 (one-month), extendable under 37 CFR 1.136(a) until six months from the mailing date. The notice alleges the following:

- The ground of rejection to be reviewed on appeal did not set forth the correct issues. For example only, claims 1 and 4 are rejected under 35 USC 102 by Speshyock et al. in one rejection and claim 6 is rejected under 35 USC 102 as anticipated, or in the alternative, under 35 USC 103(a) as obvious over Speshyock et al or Speshyock in view of Girard or Ament. Applicant is required to set out the specific grounds of rejection in this section of the appeal brief. The grounds of rejection should correspond to the Final Rejection and not to be grouped together as shown in the Brief filed 23 July 2007.

Applicant has corrected the "Ground of Rejection to be Reviewed" section of the appeal to set forth the correct issues and identically match those of the Final Rejection mailed on 09/01/2006.

Applicant respectfully requests the Commissioner to grant any extension of time that may be necessary to make this response timely. Appeal Brief should now be in compliance and its review is respectfully requested.

Respectfully submitted,



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Atty. Dkt. No. US2005-834

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Michael Anthony Eastman
Title: Compact Mirrored Contact Lens Case
Appl. No.: 10/719,834
Filing Date: 24 November 2003
Examiner: Shian T. Luong
Art Unit: 3728
Confirmation Number: 7590

BRIEF ON APPEAL

5 Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

10

Under the provisions of 37 C.F.R. § 41.37, this Appeal Brief is being filed
together with a check in the amount of \$500.00 covering the 37 C.F.R. 41.20(b)(2) appeal fee.

The PTO did not receive the following
listed item(s) check for \$500.00

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REAL PARTY IN INTEREST

The named inventors of the above-captioned application, Michael Anthony Eastman, are the real parties in interest.

5

RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any appeals or interferences that will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

10

STATUS OF CLAIMS

- | | | |
|----|-------------------|-------|
| 1. | Claims pending: | 1-14 |
| 2. | Claim cancelled: | None. |
| 3. | Claims withdrawn: | None. |
| 4. | Claims rejected: | 1-14 |
| 5. | Claims on appeal: | 1-14 |

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A full list of the claims is attached in the Claims Appendix.

20

STATUS OF AMENDMENTS

No amendment subsequent to the final Office Action dated September 1, 2006 has been filed. The examiner entered the proposed claim amendments on September 1, 2006 based on the response communication filed by Applicant on 19 July 2006 in response to the non-final Office Action dated February 27, 2006.

25

SUMMARY OF CLAIMED SUBJECT MATTER

The independent claims are Claim 1, Claim 6, and Claim 10. A concise explanation of each of the Independent claims as required under 37 CFR 41.37 follows in this section.

5 Claim 1 is directed to a contact lens case 10 for storing contact lenses comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); one or more reservoirs for storing a contact lens on the top side of said base 15 and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a corresponding cap for each of said reservoirs, said cap being attached to the outer surface 16 of said corresponding reservoir and
10 each cap having its own outer surface 16 and basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface covering for the outer surface 16 of at least one cap wherein said reflective surface covering is of a depth that is less than that of the depth of said basin 12 and is secured within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

 Claim 6 is directed to a contact lens case 10 for viewing insertion or abstraction of
15 contact lens into or from the eye comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); at least one reservoir for storing a contact lens on the top side of said base 15 and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a cap having a basin 12 for said at least one said reservoir, said cap being removeably attached to the outer surface 16 of said at least one said reservoir and having an outer surface 16
20 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface attached to the outer surface 16 of at least one said cap 13 and having a reflective outer surface 16 wherein said reflective outer surface 16 is of a depth that is less than that of the depth of said basin 12 and is secured within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1).

Claim 10 is directed to a contact lens case 10 for viewing insertion or abstraction of contact lens into or from the eye comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); on the top side of said base 15 at least one reservoir for storing a contact lens having an outer surface 16 with threads (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a cap for said at least one said reservoir, said cap being removeably attached to the outer surface 16 of each said reservoir and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface adhered to the outer surface 16 of said at least one said cap (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

The present invention comprises a novel contact lens case 10 that provides a compactly configured storage container for storing contact lenses and a reflective surface for conveniently viewing the insertion and abstraction of the contact lens into or from the eye. (Pg. 1, ll. 4-8) The contact lens case 10 is design so that it can be inexpensively molded out of a polymer. (Pg. 4, ll. 5-6) The contact lens case 10 includes two reservoirs that share a common circular bottom wall (Figs. 1-3). The reservoirs are coaxially oriented and are threaded to accept cylindrical closer caps 13 that seal the reservoirs from loss of fluid and the entry of contaminants. (Pg. 7, ll. 19-21) The cylindrical closure caps 13 engage the opposite ends of the cylindrical body and have inner peripheral surfaces that are coaxially related to the outer peripheral surfaces of the two cylindrical reservoirs of the body. (Pg. 4, ll. 5-18, Pg. 7, l. 10 – Pg. 8, l. 5) Furthermore, the top-end surface of one or more of the cylindrical closure caps 13 has adhered to or embedded into said cylindrical closure cap a reflective surface, a mirror 11 for example, allowing, as its primary function, the user to view the insertion or abstraction of the contact lens into or from the eye. (Pg. 8, ll. 10-18, and Fig. 2).

The user will hold the cylindrical closure cap containing the reflective surface (e.g. mirror 11) directly in front of the eye with one hand while inserting or abstracting the contact lens into or from the same eye with the opposite hand. Thus allowing the user to view, at close proximity, the action heretofore described. (Pg. 4, ll. 15-18).

5

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are whether:

- a) Claims 9, 12, and 14 are properly rejected on the basis of 35 USC 112, first and second paragraphs as failing to comply with the written description requirement;
- 10 b) Claims 9, 12, and 14 are properly rejected under 35 USC 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which applicant regard as the invention;
- c) Claims 1 and 4 are properly rejected under 35 USC 102(b) as being anticipated by Speshyock et al. (US 3,211,281)
- 15 d) Claim 6 is properly rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Speshyock et al. or Speshyock in view of Girard (US 2,650,597) or Ament (US 1,655,452).
- e) Claims 1-14 are properly rejected under 35 USC 103(a) as being unpatentable over Ulmer, et al. (US 3,822,780), in view of Girard and/or Ament;
- 20 f) Claims 1, 4, and 5 are properly rejected under 35 USC 103(a) as being unpatentable over De Meo (Des 358,477) in view of Girard and/or Ament;
- g) Claims 2-3 are properly rejected under 35 USC 103(a) as being unpatentable over the references applied above with respect to claim 1 above, further in view of Lin;

h) Claims 6-14 are properly rejected under 35 USC 103(a) as being unpatentable over De Meo (Des 358,477) in view of Girard and/or Ament and Lin.

STATEMENT OF THE GROUNDS OF REJECTION

Issue (a). Are Claims 9, 12 and 14 properly rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement? With respect to 35 USC 112, first paragraph, Examiner alleges the phrase “compression forces” has no support in the original specification and that adhering or embedding is not an equivalent means of securing.

Issue (b). Are Claims 9, 12, and 14 properly rejected under 35 USC 112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which applicant regard as the invention? Examiner alleges that it is not clear what “embedding means or compression forces is exerted toward the center of the depth of the basin 12” means in context of the invention.

Issue (c). Are Claims 1 and 4 properly rejected under 35 USC 102(b) as being anticipated by Speshyock et al. (US 3,211,281)? The Examiner’s position is that the claim language does not differentiate the present invention from those in the prior art and that Speshyock’s cover and base have met all the claim limitations of claim 1. There is no analysis or reasoning for the rejection of the claim elements found in Claims 1 and 4.

Issue (d). Is Claim 6 properly rejected under 35 USC 102(b) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Speshyock et al. or Speshyock in view of Girard (US 2,650,597) or Ament (US 1,655,452)? Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires

disclosure as arranged in the claim. Examiner has made no citation to such a teaching in Speshyock, Girard, or Ament.

Issue (e). Are Claims 1-14 properly rejected under 35 USC 103(a) as being unpatentable over Ulmer, et al. (US 3,822,780), in view of Girard and/or Ament? Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by Girard and Ament for lipstick cases for use on a contact lens case of Ulmer. Examiner also alleges, under *In re Oetiker*, that there is no reason to provide a citation or example that teaches a claim element, and that a statement that such is obvious is sufficient to find obviousness.

Issue (f). Are Claims 1, 4, and 5 properly rejected under 35 USC 103(a) as being unpatentable over De Meo (Des 358,477) in view of Girard and/or Ament? Examiner alleges that the claimed invention is unpatentable over De Meo in view of Girard and/or Ament stating “De Meo *appears* to have a reflective surface” and that Ament teaches “a mirror spun or crimped or suitably secured to the cap”, both without references in the citations to where these claim elements are taught or suggested. Examiner’s allegation that De Meo “appears to have a mirrored surface” is incorrect. The title, claim and description of the Figures in De Meo is absent of any reference to the type of surface or materials.

Issue (g). Are Claims 2-3 properly rejected under 35 USC 103(a) as being unpatentable over the references applied above with respect to claim 1 above, further in view of Lin? Appellant concedes that it is known in the prior art to engage the cap to the base 15 of a contact lens by thread as disclosed by Lin ‘314 and relies upon arguments made with respect to claim 1 above.

Issue (h). Are Claims 6-14 properly rejected under 35 USC 103(a) as being unpatentable over De Meo (Des 358,477) in view of Girard and/or Ament and Lin? Appellant concedes that it

is known in the prior art to engage the cap to the base 15 of a contact lens by thread as disclosed by Lin '314 and relies upon arguments made with respect to claims 6-14 above.

GROUPING OF CLAIMS

Claim 1 is an independent claims to which Claim 2, 3, 4, 5, and 13 depend. Claim 6 is an independent claim to which claims 7, 8, 9, 12, and 14 depend. Claim 10 is an independent claim to which Claim 11 depends.

All claims are directed to a compactly configured contact lens case 10 for storing contact lenses which includes at least one mirrored closure cap wherein the mirror 11 is viewable as the top surface of the closure cap. (Pg. 1, ll. 4-8, and Claims) The contact lens case 10 includes two reservoirs that share a common base 15 and are coaxially oriented and threaded to accept cylindrical closure caps 13 that engage the opposite ends of the cylindrical body and have inner peripheral surfaces that are coaxially related to the outer peripheral surfaces of the two cylindrical reservoirs of the body. (Pg. 7, ll. 19-21, Figs. 1-3) The mirrors' 11 primary function is to provide a close proximity view of the insertion or abstraction of the contact lens into or from the users' eye. The user will hold the mirrored closure cap directly in front of the eye with one hand, while performing the act of inserting or abstracting the contact lens into or from the eye with the opposite hand. (Pg. 4, ll. 15-18).

ARGUMENT

Issues (a) and (b). Claims 9, 12, and 14 comply with 35 USC 112, first and second paragraphs as they specification supports the claim elements and the claim elements are clearly defined either by their plain language definition or as defined in the specification.

Claims 9, 12 and 14 stand rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement.

Claim 9 is directed to a contact lens case 10 wherein said reflective surface is secured within said basin 12 toward the center of the depth of said basin 12 against the depth of said reflective surface. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14). Claim 12 is directed to a contact lens case 10 wherein said reflective surface is secured within said basin 12 by embedding means toward the center of the depth of said basin 12 against the depth of said reflective surface. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14). Claim 14 is directed to a contact lens wherein the securing means of the reflective surface within the basin 12 are the compression forces created by the depth of said basin 12 against the depth of said reflective surface where said reflective surface has a slightly larger diameter than said basin 12. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14).

Examiner claims the phrase “compression forces” has no support in the original specification. Appellant concedes that the application does not explicitly state that the mirror 11 is retained within the depth of the basin 12 with a “compression force”.

Appellant’s position is that the “embedding” and “adhesion” methods and means taught by the specification are well known in the manufacturing prior arts and that “embedding” involves a process comprising the steps of placing a slightly oversized object into a recess on the surface of another object, wherein by forcing the slightly oversized object into the recess, compression forces are created by the depth of the recess in order to retain the slightly oversized object in place (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14). This process of embedding, which inherently includes “compression forces”, is well known process in the manufacturing arts.

Embed is defined as: 1. to fix into a surrounding mass: to embed stones in cement; or 2. to surround tightly or firmly; envelop or enclose: Thick cotton padding embedded the precious vase in its box. In the claims the use of “securing means”, “embedding means”, and “compression forces” are defined in the specification as embedding. Embedding is one manner of securing the mirror 11 to the cap, and the use of “compression forces” which are created by placing the mirror 11 within the recessed area of the cap, the basin 12, whose walls are then used “to surround tightly or firmly; envelop or enclose”, the definition of embed, which results in the compression forces used to retain the cap.

Examiner alleges, “the step of embedding does not necessarily require an compression force toward the center of the basin 12.” In the absence of a compression force created by forcing an oversized reflective surface into the basin 12, there would be no means of securing the reflective surface to the basin 12, it would simply be sitting in a recess and would fall out when tilted at an angle or turned over. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14) To secure a reflective surface within a basin 12 of equal or larger size, and adhesive would be needed, while forcing a slightly larger reflective surface into a basin 12, resulting compression forces between the depths of their respective sides acts to secure the reflective surface within the basin 12. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14)

Claims 9, 12 and 14 stand rejected under 35 USC 112, first paragraph, as being indefinite and not clear what compression force is exerted toward the center of the depth of the basin 12. The present invention eliminates the need to use a glue or other adhesive product, instead teaching a cap with a basin 12 that has a larger depth than the reflective surface and is slightly smaller than that of the reflective surface that is to be inserted, this is Embedding. (Pg. 4, ll. 5-6, Figs. 1-2 and

4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14) The reflective surface is inserted into the basin 12 and is held in place by the compression forces exerted against its depth by the depths of the basin 12 walls. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14) During the manufacturing process the reflective surface, which is slightly larger than the basin 12 opening, is forced into the basin 12 under pressure.

Once located in the basin 12, the reflective surface's smaller depth allows it to be held in place by the compression forces of the polymer, which is slightly stretched. (Pg. 4, ll. 5-6, Figs. 1-2 and 4, Pg. 5, ll. 17-20, Pg. 6, ll. 2-7, ll. 9-11, Pg. 7, ll. 24-27, Pg. 8, ll. 9-14)

Issues (c) and (d). The subject matter of Claims 1, 4, and 6 is patentable in view of Speshyock, under 35 USC 102. With respect to claims 1, 4, and 6, Examiner cites '281, stating that it discloses a contact lens case 10 comprising: a base 15 (verified by Fig 1, '281, item 1); a cover (verified by Fig 1, '281, item 2); at least one reservoir on the top side of the base 15 having an outer surface 16 (verified by Fig 2, '281); a cover having its own outer surface 16 and attachable to the base 15 via its own threads (verified by Fig 1, '281 item 18); a reflective surface covering said outer surface 16 of said cover (verified by Fig 1, '281, item 5); and said cover having a basin 12 and the reflective surface has a depth less than the basin 12 depth.

Claim 1 is directed to a contact lens case 10 for storing contact lenses comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); one or more reservoirs for storing a contact lens on the top side of said base 15 and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a corresponding cap for each of said reservoirs, said cap being attached to the outer surface 16 of said corresponding reservoir and each cap having its own outer surface 16 and basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5,

Figs. 1-3); and a reflective surface covering for the outer surface 16 of at least one cap wherein said reflective surface covering is of a depth that is less than that of the depth of said basin 12 and is secured within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

With respect to claims 1 and 4 anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather anticipation requires disclosure as arranged in the claim. See. *W.L. Gore & Associates v. Garlock, Inc.* Claims 1, 4, and 6 were amended to include the language "in combination" explicitly making the claims a specific combination of the elements claimed therein.

Here '281 refers to a "cover." The Examiner refers to this cover containing a mirror 11. In Fig. 2 of '281, the cover that '281 refers to is removed, showing the 'lens holding portion.' The 'lens holding portion' is the contact lens case. In the first claim of '281, it also states the invention has a contact lens holding means, which includes a base 15 and cover that can have a mirror 11, and the invention has a contact lens storage means, which is the case in the present invention. They are two separate and distinct parts of '281. '281 teaches a mirrored cover case for a contact lens case, while the present invention on teaches a contact lens case 10 wherein mirrors 11 are secured to the removable caps 13, not to another case.

Column 3, lines 70-75 of '281 discusses the cover; base 15; and fluid-containing compartments bounded by bottom, sidewall and removable caps 13. The cover is separate from the removable caps 13 of the fluid containing compartments. Column 5, line 13 of '281 states "all the embodiments utilize the same lens holding cap element." This lens holding cap element is not mirrored. The cover can be mirrored. The word "mirror" appears only once in '281 in column 3 line 49.

The Examiner's description in the office action closely follows Appellant's description on page 2 of the present application and is not supported by '281 or any other cited reference. The mentioned mirrored "cover" in Examiner's rejections cannot possibly refer to '281 as the 'cover' in '281 is not a threaded connection to the base 15. The present invention describes a mirrored cover (cap) for a contact lens case 10. '281 merely describes a mirrored cover for the cover for a contact lens case. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3)

The sixth element in Appellant's claims is not taught, suggested, or anticipated by '281. Examiner provides no citation to the teaching of a cover or cap having a basin 12 wherein the reflective surface has a depth less than the basin 12 depth in '281. '281 teaches a mirrored case that holds a contact lens case (see column 3, line 48), it is *not* a mirrored contact lens case 10 but a case for a contact lens case.

Appellant emphasized the differences between the present application and the teaching of '281 and the claim language of such differentiations of the present application. Specifically, the present application is narrowly focused on a basin 12 on a cap that covers the area for storing a contact lens and is not a case for a contact lens case 10 as that taught by '281. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3). Appellant's invention incorporates a reflective surface on a contact lens case 10 in a unique and non-obvious way (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1), while '218 merely teaches a case comprising two parts, which allow for the storage of a contact lens case and other materials, with one part of the case having a reflective surface. There is no mention of teaching in '218 of how to secure the reflective surface to a case, and '281 does not teach the use of a basin 12 or any specific size. Appellants point is confirmed by Examiner's position in the office action when Examiner states "mirror appears to be attached" (emphasis added).

Issue (d). Claim 6 stands rejected under 35 USC Section 102(b) as being anticipated in view of *Speshyock et al.* (U.S. 3,211,281) hereafter referred to as '281. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration and it is not enough that the prior art reference discloses all the claimed elements in isolation, rather
5 anticipation requires disclosure as arranged in the claim. See. *W.L. Gore & Associates v. Garlock, Inc.* By Examiner's own words, and lack thereof, it is clear that '281 does not teach the use of a basin 12 for receiving a mirror 11. Examiner has made no citation to such a teaching in '281 and ever further, in under Examiner's Claim Rejections – 35 USC Section 102, Examiner writes "but in the event that it is not attached" clearly an indication the Examiner can not support
10 or is not sufficiently certain of the required disclosure under 35 USC 102 in '281.

Claim 6 is directed to a contact lens case 10 for viewing insertion or abstraction of contact lens into or from the eye comprising in combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); at least one reservoir for storing a contact lens on the top side of said base 15 and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5,
15 Figs. 1-3); a cap having a basin 12 for said at least one said reservoir, said cap being removeably attached to the outer surface 16 of said at least one said reservoir and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface attached to the outer surface 16 of at least one said cap and having a reflective outer surface 16 wherein said reflective outer surface 16 is of a depth that is less than that of the depth of said basin 12 and is secured
20 within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-2, 4).

Furthermore anticipation will not be found when the prior art is lacking or missing a specific feature or structure of the claimed invention. Here, as previously discussed, '281 does not disclose the use of basin 12 to secure the mirrored surface using embedding techniques or

compressive pressure from the side wall of a basin 12 as claimed by Appellant. Additionally,
 '218 does not teach or suggest the specific relationship of the reflective surface and the basin 12,
 such that the basin 12 wherein the reflective surface has a depth less than the basin 12 depth is
 required. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-2, 4). Withdrawal of this rejection is
 5 respectfully requested.

Issue (e). The subject matter of Claims 1-14 is patentable in view of Ulmer, et al.,
 Girard, Ament, De Meo, and Lin. Again for complicity, a prima face case of obviousness
 is established when an examiner provides: one or more references, that were available to
 the inventor and, that teach, a suggestion to combine or modify the references, the
 10 combination or modification of which would appear to be sufficient to have made the
 claimed invention obvious to one of ordinary skill in the art. Accordingly, an Appellant
 who is able to prove that the Examiner has failed to establish any one of these elements
 will prevent the prima facia case of obviousness form being established.

With respect to Claims 1-11, Examiner alleges that Ulmer discloses “a least one reservoir
 15 on the top side of the base 15 and having an outer surface 16 with threads;” and “A cap for the
 reservoir is attached to the outer surface 16 of the reservoir by threads.” This is a misstatement
 or misunderstanding of the teaching of Ulmer. Ulmer teaches a cap 18 with a base 15 fixed in
 such a manner that the cap 18 and base 20 may be removed from a container 14 with the base 20
 attached. It is the container 14, which has a mirrored surface 60, not the cap 18. Ulmer does not
 20 suggest or teach the use of a mirrored surface on the cap 18, it only teaches the use of a mirrored
 surface 60 on the container 14. Thus, Examiner’s arguments are not supported.

The cap 18 of Ulmer is separable from the lens storing area or container 14, which is the
 basis of improvement for the present invention. The present invention allows a user to remove a

cap and use a mirror 11 located on the cap to assist in the asserting of a contact into the eye (Pg.

4, ll. 6-18) while Ulmer would require a user to handle and wave around the container 14 while

using the mirrored surface 60 of the container 14, which is more difficult to hold steady due to its

weight and size with also the potential for spilling the cleaning and sterilization fluid from the

5 container 14.

Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by Girard and Ament for lipstick cases for use on a contact lens case of Ulmer. Also, with respect to

Examiner's allegation that it would be "obvious to secure the mirror 11 to present if from

inadvertent removal from the basin 12," again, how does the Examiner know that Ulmer, Girard,

10 or Ament didn't contemplate removal? The Examiner can *not* claim it is obvious under Ulmer,

Girard, or Ament to attach the mirror 11 due to its lack of teaching and the possibility of a

desirable effect for removability or attachment at a different location.

Issue. (f). With respect to Claims 1, 4, and 5 which stand rejected under 35 USC 103(a) as being unpatentable over De Meo. (De Meo) in view of Girard ('597) and/or Ament (Ament)

15 Appellant and/or Official Notice respectfully disagrees.

Claim 1 is directed to a contact lens case 10 for storing contact lenses comprising in

combination: a base 15 having a top side (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); one

or more reservoirs for storing a contact lens on the top side of said base 15 and having an outer

surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a corresponding cap for each of said

20 reservoirs, said cap being attached to the outer surface 16 of said corresponding reservoir and

each cap having its own outer surface 16 and basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5,

Figs. 1-3); and a reflective surface covering for the outer surface 16 of at least one cap wherein

said reflective surface covering is of a depth that is less than that of the depth of said basin 12 and is secured within said basin 12 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

Claim 4 is directed to the contact lens case 10 of claim 1, wherein said outer surface 16 of at least one said cap includes said basin 12. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

5 Claim 5 is directed to the contact lens case 10 of claim 4, wherein said reflective surface is adhered within said basin 12, and having a reflective outer surface 16. (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-2, 4-5).

Claim 10 is directed to a contact lens case 10 for viewing insertion or abstraction of contact lens into or from the eye comprising in combination: a base 15 having a top side (Pg. 4, 10 ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); on the top side of said base 15 at least one reservoir for storing a contact lens having an outer surface 16 with threads (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); a cap for said at least one said reservoir, said cap being removeably attached to the outer surface 16 of each said reservoir and having an outer surface 16 (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3); and a reflective surface adhered to the outer surface 16 of said at least 15 one said cap (Pg. 4, ll. 6-18, Pg. 7, l. 22 - Pg. 8, l. 5, Figs. 1-3).

With respect to independent claims, 1, 6, and 10, Appellant concedes that De Meo does teach what could be called a “standard contact lens case” which is well known in the prior art, and is incorporated in the present invention that comprises, at least one reservoir, a base 15 with an outer surface 16, and an attached cap. Examiner’s allegation that De Meo “appears to have a 20 mirrored surface” is incorrect. The title, claim and description of the Figures in De Meo is absent of any reference to the type of surface or materials. Additionally, the figures themselves show no reflective surfaces. Examiner’s position is completely nonsensical in view of all the cited prior art made of record in this prosecution and Appellant’s application, all of which clearly illustrate

reflective surfaces in their line drawings, while De Meo shows one surface appearance for the entire contact lens case.

Official Notice is also not sufficient to supply motivation for modifications. The factual inquire to modify must be based on objective evidence of records. *Ex parte Humphreys* holds that when an Examiner does not provide specific reasons to support the obviousness rejection, they have failed to establish the prima facie case of obviousness. Here Examiner fails to states the specific element or motivation that is being taken. If it is “to secure the mirror within the cap....” in view of ‘570 or Ament, then Examiner’s statements are inconsistent as Examiner first argued Official Notice in a previous Office Action, but now argues “obviousness” without being able to cite any prior art references.

With respect to Claim 6, Examiner makes no effort to cite a suggestion to combine the mirrored caps taught by Girard and Ament for lipstick cases for use on a contact lens case. Also, Examiner’s allegation that it would be “obvious to secure the mirror 11 to present if from inadvertent removal from the basin 12,” how does the Examiner know that ‘281, Girard, or Ament didn’t contemplate removal? The Examiner can *not* claim it is obvious or use hindsight under ‘281, Girard, or Ament to attach the mirror 11 due to its lack of teaching and the possibility of a desirable effect for removability.

Issues (g) and (h). With respect to Claims 2-3 and 7-8 Appellant concedes that it is known in the prior art to engage the cap to the base 15 of a contact lens by thread as disclosed by Lin ‘314. Appellant respectfully relies on the same arguments for Claim 1, from which Claims 2 and 3 depend, and Claim 6 from which Claims 7 and 8 depend.

With respect to Claims 2, 3, 4, 5, and 13, Appellant respectfully relies on the same arguments for Claim 1 from which they depend. With respect to Claims 7, 8, 9, 12, and 14

depend, Appellant respectfully relies on the same arguments for Claim 6 from which they depend. With respect to Claim 11, Appellant respectfully relies on the same arguments for Claim 10 from which it depends.

5 Appellant contends that there is no contact lens case or prior art that teaches or claims a mirror 11 embedded in one of the caps 13. While Appellant concurs with Examiner that there are mirrors embedded in cases for contact lens cases or makeup cases, Appellant respectfully disagrees that the cited prior art teaches or make obvious the present invention.

10 Claims 6-9 represent similar embodiments of the case as Claims 1-5, but instead of gluing the mirror 11 into the basin, the mirror 11 is held into the basin by the basin walls. In other words, the mirror 11 snaps into the basin and the basin itself holds the mirror 11 in place by compression forces of the molded plastic basin walls and case (depths). For manufacturing and cost reasons this is the way the case is made now and sold. The mirror 11 can be snapped into the basin, forced out of the basin, and then snapped back into the basin.

CLAIMS APPENDIX

1. A contact lens case for storing contact lenses comprising in combination:

a base having a top side;

one or more reservoirs for storing a contact lens on the top side of said

5 base and having an outer surface;

a corresponding cap for each of said reservoirs, said cap being attached to
the outer surface of said corresponding reservoir and each cap having its own
outer surface and basin; and

a reflective surface covering for the outer surface of at least one cap

10 wherein said reflective surface covering is of a depth that is less than that of the
depth of said basin and is secured within said basin.

2. The contact lens case of claim 1, wherein said outer surface of said reservoir includes threads.

15 3. The contact lens case of claim 2, wherein each said cap has an inner surface that includes
threads adapted to engage said threads of said reservoir.

4. The contact lens case of claim 1, wherein said outer surface of at least one said cap includes
said basin.

20

5. The contact lens case of claim 4, wherein said reflective surface is adhered within said basin,
and having a reflective outer surface.

6. A contact lens case for viewing insertion or abstraction of contact lens into or from the eye comprising in combination:

a base having a top side;

at least one reservoir for storing a contact lens on the top side of said base and having an

5 outer surface;

a cap having a basin for said at least one said reservoir, said cap being

removeably attached to the outer surface of said at least one said reservoir and

having an outer surface; and

a reflective surface attached to the outer surface of at least one said cap and having a

10 reflective outer surface wherein said reflective outer surface is of a depth that is less than that of the depth of said basin and is secured within said basin.

7. The contact lens case of claim 6, wherein said outer surface of said reservoir includes threads.

15 8. The contact lens case of claim 8, wherein said cap has an inner surface that includes threads adapted to engage said threads of each respective said reservoir.

9. The contact lens case of claim 8, wherein said reflective surface is secured within said basin toward the center of the depth of said basin against the depth of said reflective surface.

20

10. A contact lens case for viewing insertion or abstraction of contact lens into or from the eye comprising in combination:

a base having a top side;

on the top side of said base at least one reservoir for storing a contact lens having an outer surface with threads;

a cap for said at least one said reservoir, said cap being removeably

attached to the outer surface of each said reservoir and having an outer surface;

5 and

a reflective surface adhered to the outer surface of said at least one said cap.

11. The contact lens case of claim 10, wherein said cap has an inner surface that includes threads adapted to engage the threads of each respective said reservoir.

10

12. The contact lens case of claim 8, wherein said reflective surface is secured within said basin by embedding means toward the center of the depth of said basin against the depth of said reflective surface.

15 13. The contact lens case of claim 4, wherein said reflective surface is embedded within said basin, and having a reflective outer surface.

14. The contact lens case of claim 9, wherein the securing means of the reflective surface within the basin are the compression forces created by the depth of said basin against the depth of said reflective surface where said reflective surface has a slightly larger diameter than said basin.

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EVIDENCE APPENDIX

None.

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RELATED PROCEEDINGS APPENDIX

None.

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SUMMARY

For the foregoing reasons in the Arguments section, it is submitted that the Examiner's rejections are erroneous, and reversal of the applied rejections is respectfully requested.

5

Respectfully submitted,

Date 19 Nov. 2007

By 

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